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WILLIBALD KRAUS

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FAY, SHARPE, BEALL, FAGAN,
MINNICH & MCKEE
1100 SUPERIOR AVE., STE 700
CLEVELAND, OH 441142518

EXAMINER

JOYCE, HAROLD

ART UNIT

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 40

Application Number: 08/230,083
Filing Date: April 20, 1994
Appellant(s): KRAUS, WILLIBALD

Michael E. Hudzinski
For Appellant

MAILED
JUL 23 2004
GROUP 3700

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed October 4, 2000 and supplemental brief on appeal filed May 7, 2002.

A statement identifying the real party in interest is contained in the brief.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

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(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments after Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 14 and 16 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 14 and 16 are rejected under the equitable "recapture" doctrine which prevents a reissue applicant from obtaining subject matter surrendered in an attempt to obtain allowance of the original patent claims. This rejection is set forth in prior Office Action, Paper No. 30.

(11) Response to Argument

Background:

The only issue on appeal relates to claims 14 and 16, both newly added claims, in the reissue application, which are rejected under 35 U.S.C. § 251 based on the recapture doctrine. In the application for the patent now sought to be reissued, originally filed dependent claims 2 (de-

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pendent on claim 1) and 12 (dependent on claims 1, 10 and 11) were objected to, and it was indicated in the first Office action that the claims would be allowable if placed in an independent format. The remainder of the claims were rejected over prior art. On amendment in response to the first Office action, the applicant basically rewrote claims 2 and 12 in independent format, as new claims 15 and 16, respectively (which became **patent claims 1 and 11**, respectively). The dependencies of originally filed claims 3-11 were also amended to depend from new claim 15. Neither the examiner nor the applicant gave any reasons as to why originally filed claims 2 and 12 had allowable subject matter.

Analysis and Response to the Remand:

A table is provided as Appendix A of this supplemental examiner's answer, and all elements discussed in the following analysis can be found in that table.

In the present instance, the original independent claims, which were rejected by the examiner based on prior art, did not contain:

Element E: a surrounding rim on the inner frame carrying rib members spaced transversely with stays extending therefrom and a surrounding frame joining the stays [From original claim 2 of the original application; claim 2 was objected to and found patentable in the original application]

Element Z: wherein the locking element is guided over a **dovetail guide** on the outer surface of the outer housing [From original claim 12 of the original application; claim 12 was objected to and found patentable in the original application]

To overcome the prior art rejection against the claims not having either limitation E or limitation Z, the applicants rewrote those claims to add either limitation E or limitation Z, from the relevant dependent claims. The examiner had suggested that such rewritten claims would be allowable, and the applicant made the choice of inserting one of those dependent claim limitations into all the claims by rewriting objected-to dependent claims 2 and 12 as independent claims. The applicant chose not to prosecute further variations of the original independent claim. At the present, on reissue, applicant is not permitted to completely delete the added limitations. See *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), discussed below.

Eggert: The decision in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) is **not applicable** to the facts of this appeal. The claims on appeal omit the surrender-generating limitations (i.e., the limitation(s) added to define over the art to secure allowance). This is because the limitations of claims 2 or 12, which are represented as element E or Z below, respectively, in their entirety, are absent from the reissue claims being rejected based on recapture. Therefore, the claims impermissibly recapture what was previously surrendered as explained in more detail below. Again, see Appendix A for a complete definition of the different elements represented below.

Claim 14 in the reissue application is basically the same as originally filed dependent claim 10 but with a more specific recitation of the "spring tongue" feature X that was set forth in **originally** filed claim 10. Originally filed claim 10 was rejected under 35 U.S.C. § 103 in view of

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prior art. Claim 10 was amended to add the surrender-generating limitation E ("surrounding rim...joining the stays") and the claim was allowed as such.

Originally filed claim 10: ABCDX

Allowed claim 10, as amended: ABCDEX

Reissue claim 14: ABCD'X_{sp}

Reissue claim 14 completely omits the surrender-generating limitation of originally filed claim 2 (element E), and therefore, impermissibly recaptures what was previously surrendered. Making element X more specific does not save the claim from recapture, since X is not at all related to E which was omitted. It is to be noted that element Z (which was added to claim 12 in the original application) is also not made a part of reissue claim 14. Thus, claim 14 contains neither element E nor element Z.

Claim 16 in the reissue is basically the same as originally filed dependent claim 11 with a broader limitation (represented as element X_{br}) than in **originally** filed claim 10 from which **originally** filed claim 11 depended. X_{br} does not mention the "springy tongue." Original claim 11 did, however, add limitation Y directed to a locking element, which is also found in the reissue claim. Originally filed claim 11 was rejected under 35 U.S.C. § 103 in view of prior art.

Originally filed claim 11: ABCDXY

Allowed claim 11, as amended: ABCDEXY

Reissue claim 16: ABCDX_{br}Y

Reissue claim 16 omits the surrender-generating limitation of originally filed claim 2 (element E), and therefore, impermissibly recaptures what was previously surrendered. In this instance, *there is no replacement narrowing limitation at all.*

Alternatively, applicant states that claim 16 is basically the same as **originally** filed claim 12 which became patent claim 11. Viewed in this manner, reissue claim 16 is essentially originally filed claim 12 without the limitation of claim 12 (represented as element Z) and with a broader statement of the limitation of claim 10 (represented as element X_{br}).

Originally filed claim 11: ABCDXY

Allowed claim 12, (patented claim 11): ABCDXYZ

Reissue claim 16: ABCDX_{br}Y

Reissue claim 16 omits the surrender-generating limitation of originally filed claim 12 (element Z), and therefore, impermissibly recaptures what was previously surrendered. *Again, no replacement narrowing limitation has been added at all.*

Response to Applicant's supplemental Appeal Brief of May 7, 2002 (Paper No. 38):

In reply to an Order by the BPAI, applicant submitted a supplemental Appeal Brief to address issues relating to *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), which was decided while the application was under appeal. In the supplemental appeal brief, the applicant states that "[t]he Pannu decision has no impact on the rejection before the Board in the instant appeal" (see page 2). The applicant explains in great detail the prosecution history of the claims and contends that "... no limitations were added to the base claims to overcome prior art rejections." (see page 2). Applicant bases this conclusion on the fact that claim 1 was never "amended" but instead merely cancelled when the application was amended to rewrite allowable claims 2 and 12 into independent form. (see page 7). Specifically, applicant argues that the elimination of the features of claim 2 in reissue claim 14 and the elimination of the

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features of claim 12 in reissue claim 16 do “not relate in any way to any subject matter that could fairly be considered to be ‘surrendered’ during prosecution.” (see pages 8 and 10).

The examiner respectfully disagrees with applicant’s statement that no limitations were added to the base claims to secure a patent. Applicant cancelled the broad claim 1 in favor of narrower dependent claims 2 and 12 during the prosecution of the patented file in order to obtain a patent. Applicant did not choose other prosecution options, such as challenging the examiner’s rejection or filing a continuing application, in order to obtain broader patent protection. Additionally, reissue claims 14 and 16 are broader than the original patent claims 1 and 11 by not including the surrender-generating limitations of originally filed claims 2 or 12. This broadening of the claims is barred by the recapture rule even if there is narrowing of the claims not related to the surrender-generating limitations.

In view of *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), if a reissue claim is broader in an aspect germane to what was surrendered in response to a prior art rejection, but narrower in another aspect completely unrelated to what was surrendered, the recapture rule bars the claim. This is the understanding of how the shorthand set forth in *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 for the broadening/narrowing scenario 3(a), is applied in light of *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) and *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001) both of which pointed out that one should look at the limitation **relied upon to define the invention over the prior art**, and determine if that limitation is omitted in the reissue claims. Note also the statement in *Clement* that every time the claims are narrowed by amendment, subject matter is surrendered. *Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166 (“[E]very time *Clement* amended his claims, he intentionally omitted or abandoned the claimed subject matter.”).¹

The limitations of claims 2 and 12 are germane to what was surrendered in response to a prior art rejection, as these claims were indicated allowable when the claim from which they depended (e.g., claim 1 or claim 11) was rejected under prior art. Therefore, the limitations of claims 2 and 12 were necessary in order to secure a patent. Similar to the facts in *Pannu*, the applicant has broadened the reissue claims in an aspect germane to what was surrendered in response to the prior art rejection. For reissue claim 14, the claim has been narrowed in an area not related to the surrender. Therefore, the decision in *Pannu* is relevant to the issue on appeal because it provides an actual fact situation in which this scenario was held to be recapture. For reissue claim 16, we need not reach the *Pannu* issue, because the surrender-generating limitations (Z and E above) are omitted in the claim and are not replaced by any narrowing limitation.

Applicant has an erroneous assessment on pages 10 and 11 of the Reply Brief, that under *In re Clement* the surrendered subject matter is the subject matter of original claim 1, MPEP 1412.02 states:

¹ This statement that every time the claims are narrowed by amendment, subject matter is surrendered, calls for analyzing reissue claims for whether a key narrowing that was made in the original prosecution has abandoned, i.e., surrendered, subject matter that the patent owner is now seeking to recapture by reissue. Thus, the insertion of a narrowing unrelated to the abandoned (surrendered) claim subject matter that owner is impermissibly trying to recover does not save the claim from the recapture doctrine.

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If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

In the instance case, the surrendered subject matter as viewed from applicant's Reply Brief **Tables I and II**, is any claim not having either the limitation represented by the last six lines of Patent Claim 1 or the limitation represented by the last four lines of patent claim 11.

Additionally the Examiner's position is set forth in the prior Office Action, Paper No. 30.

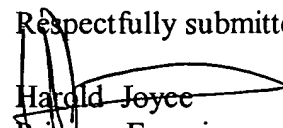
For the above reasons, it is believed that the rejections should be sustained.

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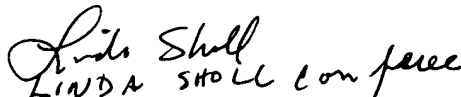
Respectfully submitted,


Harold Joyce
Primary Examiner
Art Unit 3749

HJ

FAY, SHARPE, BEALL, FAGAN,
MINNICH & MCKEE
1100 SUPERIOR AVE., STE 700
CLEVELAND, OH 44114-2518


Ira S. Lazarus
Supervisory Patent Examiner
Group 3700


LINDA SHALL con ferce
SPRE TC3700

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Appendix A

Elements	Originally filed/patented Claims	Reissue Claim 14	Reissue Claim 16
ABCD	Claim 1 and patented claims 1 and 11: A: outer housing B: inner frame C: check valve element D: resilient clip connection for joining the outer housing, inner frame and check valve element	A: outer housing B: inner frame C: check valve element D': a <i>first and second</i> resilient clip connection for joining the outer housing, inner frame and check valve element	A: outer housing B: inner frame C: check valve element D: resilient clip connection for joining the outer housing, inner frame and check valve element
E	Claim 2 (depends on claim 1) and Patented claim 1: E: a surrounding rim on the inner frame carrying rib members spaced transversely with stays extending therefrom and a surrounding frame joining the stays	N/A	N/A
X	Claim 10 (depends on claim 1) and Patented claim 11: X: wherein the clip connection comprises a springy tongue formed separate from the outer housing	X_{sp}: the first clip connection comprises a first springy tongue spaced from the outer housing and the second clip connection comprises a second springy tongue integral with the outer housing	X_{br}: the resilient clip connection is formed separate from the outer housing
Y	Claim 11 (depends on claim 10) and Patented claim 11: Y: wherein the springy tongue is arranged on a locking element which can be connected with the outer housing	N/A	Y: the resilient clip is carried on a locking element connected with the outer housing
Z	Claim 12 (depends on claim 11) and Patented claim 11: Z: wherein the locking element is guided over a dovetail guide on the outer surface of the outer housing	N/A	N/A